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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/089,901	06/03/98	SHOJI M	YAMAP0575US

LM02/0915

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EXAMINER	
PSITOS,A	
ART UNIT	**PAPER NUMBER**
2752	9

DATE MAILED: 09/15/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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PTO-90C (Rev. 2/95) 1- File Copy

U.S. G.P.O. 2000 ; 485-188/25266

Office Action Summary	Application No. 09/089,901	Applicant(s) Shoji et al
	Examiner Psitos	Group Art Unit 2752

☒ Responsive to communication(s) filed on *Aug. 7, 2000*.

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *three* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-20* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-20* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Applicants' communication, amendments & arguments, of Aug. 7, 2000 has been considered with the following results.

Claim Rejections - 35 U.S.C. § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular, the continuous recording/reproducing as now claimed is not adequately disclosed. What/how such is accomplished is not found in the present application.

As far as the examiner can ascertain from the disclosure, the following art rejection are made

Claim Rejections - 35 U.S.C. § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1,2,7,9,11,12,17 and 19 are rejected under 35 U.S.C. 103. (a) as being unpatentable over the acknowledged prior art JP 4-141827 further considered with Moriya et al.

The references are relied upon for the reasons stated in the previous Office action.

Applicants' arguments/amendments have been considered but are not deemed persuasive because as interpreted by the examiner - see col. 12 lines 35-55 the recording technique described therein meets the claimed invention.

6. Claims 3 and 13 are rejected under 35 U.S.C. 103 (a) as being unpatenable over the art as applied to claims 1,2,11 and 12 above and further considered with the acknowledged prior art.

The references are relied upon for the reasons of record. No further rebuttal is considered necessary.

5. Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 3 and 13 above, and further in view of Johann et al.

The references are relied upon for the reasons of record - no further rebuttal is necessary.

6. Claims 5 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 4 above, and further in view of the acknowledged prior art.

The reasons stated in the previous office action are repeated and maintained, no further rebuttal is necessary.

7. Claims 6 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 3 and 13 above, and further in view of the acknowledged prior art.

The reasons stated in the previous Office action are repeated and maintained, no further rebuttal is necessary.

8. Claims 8,10,18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1 and 11 above, and further in view of Piertrzykoski et al.

The reasons stated in the previous office action are repeated and maintained, no further rebuttal is necessary.

9. Claims 1,2,7,9,11,12,17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the acknowledged prior art JP 4-141827 considered with Moriya et al and both further considered with Nakane et al (any of the patents - 6091669, 5936932, or 5946285).

JP 4-141827 and Moriya et al are relied upon for the reasons stated above and in the previous Office action.

Applicants' arguments appear to ***imply*** that the recording capability of Moriya et al is somehow not continuously. If applicants' could positively distinguish there over it would appear that the format applicants' are attempting to define is that know in the art as SS-L/G.

This format is know as taught by any of the patents to Nakane et al.

It would have been obvious to one of ordinary skill in the art to modify the above system of JP 4-141827 & Moriya et al with the additional format teaching from Nakane et al - motivation being to reduce unnecessary "jumping time" and hence increase operational efficiency.

10. Claims 3 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1,2,11 and 12 above, and further in view of the acknowledged prior art.

The additional limitations of these claims are acknowledged to be well known in the art as stated in paragraph 5 of the previous Office action. The same reasons presented therein are repeated herein.

11. Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as as applied to claims 3 and 13 above, and further in view of Johann et al.

The ability of establishing an average of a parameter is considered to be well known as taught by the Johann et al reference.

The reasons for the combination are stated in paragraph 6 of the previous Office action and are repeated herein.

12. Claims 5 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 4 above, and further in view of the acknowledged prior art.

The limitations of claims 5 and 15 are acknowledged as being well known - see page 29 of the specification. The reasons for the combination are stated in paragraph 7 of the previous Office action and are repeated herein..

13. Claims 6 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 3 and 13 above, and further in view of the acknowledged prior art.

The reasons stated in paragraph 8 of the previous Office action are repeated herein.

14. Claims 8,10,18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1 and 11 above, and further in view of Pietrzykoski et al.

The ability of having a plurality of parameters optimized is considered a duplication of effort as taught by Pietrzyskoski et al.

The reasons for the combination are stated in paragraph 9 of the previous Office action and are repeated herein.

15. In summary, applicants' amendments and arguments:

a) do not distinguish over the Moriya et al format - for the reasons stated above.

15. b) if applicants are attempting to define the SS L/G format - such is well known as taught by the Nakane et al references.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on

the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M. Psitos whose telephone number is (703) 308-1598.

amp

September 13, 2000

ARISTOTELIS M. PSITOS
PRIMARY EXAMINER
AU 2752